

Remarks:

Claims 1-3, 7, 8, 10-13, and 18-24 are pending in the current application and rejected under 35 U.S.C. §112 / 35 U.S.C. §103. No new matter is added as support for the pending claim is provided within the specification and the claims as filed. Please note that Applicant intends to file a preliminary amendment subsequent to this amendment with further amendments to the claims and more detailed remarks.

The Applicant is not conceding that the subject matter recited in the amended or canceled claims is not patentable over the art cited by the Examiner. The amended or canceled claims are provided solely to facilitate expeditious prosecution of the allowable subject matter. Applicant respectfully reserves the right to pursue claims, including the subject matter encompassed by the amended or canceled claims in one or more continuing applications.

§112 Rejection(s):

Claims 1-3, 7, 8, 10-13, and 18-24 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. The Examiner contends that 1) “entering one or more values by the user with the configuration data,” 2) “wherein the configuration data is compared with respective records of the database for consistency,” and 3) if the data is found to be inconsistent “comparing the configuration data with a range of values to determine if the data is valid” is not disclosed or in the specification.

The Examiner is reminded that §112, first paragraph, requires for the specification to adequately support the subject matter claimed rather than mirroring the claim language word for word. MPEP §2163, *Moba, B.V. v. Diamond Automation, Inc.*, 325 F.3d 1306, 1319, 66 USPQ2d 1429, 1438 (Fed. Cir. 2003); *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d at 1563, 19 USPQ2d at 1116.

Support can be provided “in a variety of ways” and “using such descriptive means as words, structures, figures, diagrams, and formulas” to “show that the applicant was in possession of the claimed invention. *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997). See, e.g., *Pfaff v. Wells Elecs., Inc.*, 525 U.S. 55, 68, 119 S.Ct. 304, 312, 48 USPQ2d 1641, 1647 (1998).

Further, claim limitations may be supported in the specification through “express, implicit, or inherent disclosure.” See *In re Oda*, 443 F.2d 1200, 170 USPQ 268 (CCPA 1971). Referring to the specification pages 1-12 and figures 1-7 of the present application, a reasonable person reviewing the entire disclosure would clearly find that the applicant at the time of filing of the application was in possession of (and disclosed both explicitly and implicitly) the claimed features related to establishing a telephone communication between two or more parties and that the claimed device is not wearable on a person’s wrist.

Contrary to the Examiner’s understanding, section §112, first paragraph does not require a word-for-word matching between the language in the specification and the language recited in the claims. If one were to interpret §112, first paragraph, according to the Examiner’s understanding, then the claim language would have to be limited to *identical* language used in the specification and nothing more.

Referring to MPEP 2163 (II) (A), “[t]he examiner has the initial burden, after a thorough reading and evaluation of the content of the application, of presenting evidence or reasons why a person skilled in the art would not recognize that the written description of the invention provides support for the claims. There is a strong presumption that an adequate written description of the claimed invention is present in the specification as filed, *Wertheim*, 541 F.2d at 262, 191 USPQ at 96.”

The specification as filed supports the rejected claim language. Paragraph [0047] supports the above-noted element (1), and paragraph [0050] through [0054] support the above-noted elements (2) and (3).

Respectfully, the Examiner has misinterpreted the requirements of §112 in rejecting the claims. Pursuant to MPEP §2163 (II) (A) and §2163.04, the Examiner is requested to present “evidence or reasoning to explain why persons skilled in the art would not recognize in the

disclosure a description of the invention defined by the claims,”¹ or otherwise withdraw the rejection.

§103 Rejection(s):

Claims 1, 3, 11, 13, 21, and 23 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Publication No. 2005/0164692 to Roth et al (“Roth”) in view of U.S. Patent Publication No. 2002/0123368 to Yamadera et al. (“Yamadera”), U.S. Patent Publication No. 2002/0107868 to Childs et al. (“Childs”), and U.S. Patent No. 5,125,091 to Staas, Jr. et al. (“Staas”). Claims 22 and 24 are rejected under 35 U.S.C. §103(a) as being unpatentable over Roth in view of Yamadera, Childs, Staas, and U.S. Patent Publication No. 2002/0128908 to Levin et al. (“Levin”). Claim 7 and 18 are rejected under 35 U.S.C. §103(a) as being unpatentable over Roth in view of Yamadera, Childs, Staas, and U.S. Patent Publication No. 2003/0208704 to Bartels et al. (“Bartels”). Claim 10 and 20 are rejected under 35 U.S.C. §103(a) as being unpatentable over Roth in view of Yamadera, Childs, Staas, and U.S. Patent Publication No. 2005/0079863 to Macaluso (“Macaluso”). Claims 8 and 19 are rejected under 35 U.S.C. §103(a) as being unpatentable over Roth in view of Yamadera, Childs, Staas, and U.S. Patent Publication No. 2005/0073991 to Roberts et al. (“Roberts”). Claims 2 and 12 are rejected under 35 U.S.C. §103(a) as being unpatentable over Roth in view of Yamadera, Childs, Staas, and U.S. Patent Publication No. 2004/0166839 to Okkonen et al. (“Okkonen”). These rejections are respectfully traversed.

It has been long held that, to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, a reference (or references when combined) must teach or suggest all the claim limitations.

¹ MPEP § 2163.04 “If applicant ... points out where and/or how the originally filed disclosure supports the amendment(s), and the examiner finds that the disclosure does not reasonably convey that the inventor had possession of the subject matter of the amendment at the time of the filing of the application, the examiner has the initial burden of presenting evidence or reasoning to explain why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims.”)

In other words, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed subject matter where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ 2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ 2d 1941 (Fed. Cir. 1992).

Further, according to MPEP §2143,² to establish a prima facie case of obviousness, the Examiner must clearly articulate the reason(s) why the claimed subject matter would have been obvious at the time of invention. Exemplary rationales that may support a conclusion of obviousness include:

- (a) Combining prior art elements according to known methods to yield predictable results;
- (b) Simple substitution of one known element for another to obtain predictable results;
- (c) Use of known technique to improve similar devices (methods, or products) in the same way;
- (d) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results; etc.

The cited references fail to teach or suggest all the elements recited in claim 1. It is respectfully noted that §103 does not allow the Examiner to engage in a picking and choosing from the prior art only to the extent that it will support a holding of obviousness, while excluding parts of the prior art essential to the full appreciation of what the prior art suggests to one of ordinary skill in the art. *In re Wesslau*, 147 USPQ 391 (CCPA 1975).

The question of whether a reference can properly be modified in a §103 rejection is not whether a particular limitation was known at time of invention, but rather whether there is a reason or suggestion for a person of ordinary skill in the art to modify the reference to include that particular limitation. As the U.S. Supreme Court has affirmed, "a patent composed of

several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art... it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does." See *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741, 82 USPQ 2d 1385, 1397 (2007).

Additionally, while a reason or suggestion to modify or a reference may come from the knowledge and common sense of a person of ordinary skill in the art, the fact that such knowledge may have been within the province of the ordinary artisan does not in and of itself make it so, absent clear and convincing evidence of such knowledge. *C.R. Bard, Inc. v. M3 Systems, Inc.*, 157 F.3d 1340, 1352, 48 USPQ 2d 1225, 1232 (Fed. Cir. 1998).

Here, the modifications proposed by the Examiner are not based on any clear and convincing evidence of a reason or suggestion that would have motivated a person of ordinary skill in the art to combine the cited references. As such, the modifications proposed by the Examiner are simply impermissible hindsight reconstruction given the benefit of Applicant's disclosure. The Federal Circuit has consistently held that hindsight reconstruction does not constitute a prima facie case of obviousness under 35 U.S.C. §103. *In re Geiger*, 2 USPQ 2d 1276 (Fed Cir. 1987).

Unfortunately, the Examiner, rather than pointing to what the prior art discloses or suggests, relies on assumptions and statements without any support in the record. Consequently, the Examiner's statements regarding obviousness and motivation to combine are but shortcuts to a conclusion of obviousness devoid of the required analytical approach based on what is actually disclosed or suggested in the prior art.

Reliance on impermissible hindsight to avoid express limitations in the claims and setting forth unsupported hypothetical teachings to recreate the Applicant's claimed subject matter cannot establish a prima facie case of obviousness. Applicant respectfully invites the Examiner

2 *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1739-1741, 82 USPQ 2d 1385, 1395-97 (2007).

to point out the alleged motivation to combine with specificity,³ or, alternatively, provide a reference or affidavit in support thereof, pursuant to MPEP §2144.03.⁴

For the above reasons, it is respectfully submitted that claim 1 should be in condition for allowance. Claims 2, 3, 7, 8, 10, 23, and 24 depend on claim 1 and should be in condition for allowance by virtue of their dependence on an allowable base claim. Claim 11 substantially incorporates the elements of claim 1; therefore, claim 11 and claims 12, 13, and 18-22 depending therefrom should also be in condition for allowance.

No amendment made was related to the statutory requirements of patentability unless expressly stated herein; and no amendment made was for the purpose of narrowing the scope of any claim, unless Applicant has expressly argued herein that such amendment was made to distinguish over a particular reference or combination of references.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles, California, by way of telephone (888) 789 2266 or email jfarhadian@i-p-law.us, to discuss the steps necessary for placing the application in condition for allowance.

Respectfully submitted,

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3 ACS Hospital Systems, Inc. v. Montefiore Hospital, 221 USPQ 929, 933 (Fed. Cir. 1984).

4 “The rationale supporting an obviousness rejection may be based on common knowledge in the art or “well-known” prior art . . . If the applicant traverses such an assertion the examiner should cite a reference in support of his or her position. When a rejection is based on facts within the personal knowledge of the examiner . . . the facts must be supported, when called for by the applicant, by an affidavit from the examiner.”